

## **REMARKS**

### **Claim Rejections**

Claims 1-3, 7-9, 12-14, 18-20, 33-35, 39-41, and 43 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art (Specification 1:24 to 2:8), Bennett '178 and U.S. Patent No. 6,485,367 (Joshi).

Claims 4, 15, 36, and 44 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art, Bennett '178, Mayeroff and Joshi.

Claims 10, 11, 21, and 22 stand rejected as obvious over Bennett '102 in view of Appellant's Admitted Prior Art, Bennett '178, Walker and Joshi.

### **Claims Amendments**

The claims have been amended to eliminate these rejections. Support for the amendments may be found, for instance, at the following locations in Applicant's specification: page 13, line 29 to page 14, line 1; page 16, line 22 to page 17, line 14; page 19, lines 13-29. It is respectfully submitted that the amended claims are directed to allowable subject matter.

### **Applicant's Invention Would Not Have Been Obvious**

Three criteria must be met to establish obviousness. First, the prior art must provide one of ordinary skill in the art with a suggestion or motivation to modify or combine the teachings of the references relied upon in rejecting the claims. Second, the prior art must provide one of ordinary skill in the art with a reasonable expectation of success. Third, the prior art, either alone or in combination, must teach or suggest each and every limitation of the rejected claims. The teaching or suggestion to make the claimed invention, as well as the reasonable expectation of success, must come from the prior art and not from Applicant's disclosure. If any one of these criteria is not met, a case of obviousness is not established. Also, some articulated reasoning with rational underpinnings must be provided to support a *prima facie* case of obviousness.

The combination of references relied upon in rejecting Applicant's claimed invention does not result in that invention. Thus, a *prima facie* case of obviousness has not been made out.

Applicant's claimed invention, for instance, as called for by claim 1, requires that the controller is programmed to receive data relating to a request from a person made during the occurrence of a wagering game for the controller to make an automated selection from among a plurality of user-selectable options presented to the person. Additionally, the controller is programmed to allow the person a choice of making an initial selection from among the user-

selectable options at the start of the wagering game or to instruct the controller at the start of the wagering game to make the automated selection.

Joshi does not disclose this feature of Applicant's claimed invention. Instead, in Joshi, the CPU of the gaming machine 10 is configured to make a recommendation at the start of each and every game. (Col. 4, lines 43-60; Col. 8, line 66 to Col. 9, line 17). The CPU is not programmed to allow a player to choose between making an initial selection from among a number of possible selections at the start of a game or instructing the controller at the start of the game to make an automated selection. That is, in Joshi's gaming machine, a player is not given an option as to whether the CPU makes a recommendation as to how a game is to be played. The CPU, in every instance, makes a recommendation as to a selection at the start of every game.

Thus, in this respect, Joshi clearly teaches away from Applicant's claimed invention wherein a player is allowed to choose between making an initial selection from a number of user-selectable options at the start of a game or instructing the controller at the start of the game to make an automated selection.

### **Conclusion**

In view of the forgoing, it is respectfully submitted that all of the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorney at (510) 663-1100.

The Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 504480 (Order No. IGT1P530).

Respectfully submitted,  
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